

REMARKS

Claims 1-8 and 14-17 are pending with all claims rejected in view of combinations of the seven references, including *Ludewig, et al.* (US Patent No. 6,327,609), *Capps, et al.* (US Patent No. 6,735,691), *Pogue, et al.* (US Patent No. 6,112,240), *Davis, et al.* (US Patent Application No. 2002/0040395), *Shrader, et al.* (US Patent No. 6,374,359), *Bharat* (US Patent No. 6,810,395), and *de l'Etraz, et al.* (US Patent No. 6,073,138). Claim 14 is amended.

At least in light of the claim limitations and amendments listed above and the foregoing remarks, issuance of the allowed claims is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

The pending claims include two independent claims: (a) claim 1 teaching a method for tracking and reporting traffic activity on a web site, and (b) claim 14 teaching a method for analyzing activity on a web page of a web site. The Office Action cites different art in rejecting each claim set:

- Claim 1 is rejected in view of a combination of the Ludewig and Capps references, with remaining dependent claims 2-8 rejected also in view of the Pogue, Davis, and Shrader references.
- Claims 14-15 are rejected in view of a combination of the Bharat and de l'Etraz references, with remaining dependent claims 16-17 rejected also in view of the Pogue reference.

Responsive to Applicants' arguments, the Examiner withdrew a previous rejection that claims 1-8 are an obvious combination of the previously cited Durham reference (US Patent No. 6,330,566) with the still-cited Capps reference. The Examiner has conducted a new search and has now cited a new reference, Ludewig, as evidence that the concept of cookie processing script is known in the art and readily combinable with the Capps-disclosed features of data mining code. It is not clear, however, that Ludewig in fact teaches such cookie processing script with features of the invention. Also, the sheer number of references combined to teach features of the invention is evidence that such combination would not be obvious and instead is an inappropriate application of hindsight.

I. Claims 1-8

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ludewig, et al. (US Patent No. 6,327,609) and Capps, et al. (US Patent No. 6,735,691).

Claims 2 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capps and Ludwig as applied to claim 1 above, and further in view of Pogue, et al. (US Patent No. 6,112,240).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capps, Pogue and Ludewig as applied to claims 1 and 2 above, and further in view of Davis, et al. (US Patent Application No. 2002/0040395).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capps, Ludewig, Pogue and Davis as applied to claims 1-3 above, and further in view of Shrader, et al. (US Patent No. 6,374,359).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capps, Pogue, Davis and Ludewig.

A. *Ludewig is not combinable with the Capps reference to operate as noted in the claims and therefore would not properly be considered "cookie processing script" as cited*

While we are pleased that our arguments to the previous Office Action were successful in removing the rejections to the claims in view of the Capps and Durham patents, the Examiner has conducted yet another prior art search and now rejects all claims based on new art. In particular, the Examiner cites the Ludewig reference (U.S. Pat. No. 6,327,609) as teaching "cookie processing script" in the form of Java applets that store cookie data relating to the preferences of a client. [see, e.g., Ludewig col. 5, lines 40-50]

It appears that the Examiner is again mixing references that would not necessarily be operable if combined together. For instance, the Examiner states that it would be obvious to use the data mining code taught in Capps (U.S. Pat. No. 6,735,691) to obtain web browsing data and then operating the Java applets on that data to obtain new cookie values.

By our reading, the Ludewig Java applets appear pre-programmed at the server to store certain cookie values at the client irrespective of the traffic data that data mining code would compile. As stated in the Ludewig patent:

The particular Java applet transmitted to client 135 is selected based on the type of Web page 320 transmitted to client 135 from server 110.

[Ludewig, col. 5, lines 29-31]

That is, the Java applet and accompanying Java cookie values are set at the server and only stored on the client based on a retrieved web page. This is similar to the prior art method of server-side cookies since the cookie values are determined based on a single web page access rather than a data mining that takes place on the visitor computer as in the present claims.

For example, Ludewig teaches that the Java applet returned with sound and/or video content for a particular brand of mountain bike would store a cookie indicating interests in mountain bikes. It is not clear at all that this cookie can in any way be changed—rather additional cookies are added and read in concert whenever the user expressed additional interested. This can be seen in Ludewig column 6, lines 1-2, 22-25 where the individual cookie data 420 and 421 is stored for “each applet 410, 411” (thus indicating that each applet stores its own new cookie values rather than overwriting old values) and “cookie 420 may contain data indicating that client 135 prefers outdoor activities [while] cookie 421 may contain information on the airline that client 421 prefers to use when traveling.” This cookie data appears to be mutually exclusive and thus there appears to be no need to modify the existing cookies. For instance, there is no disclosure within Ludewig that would suggest how an applet would change cookie 421 to Jet Blue from American Airlines if the user’s airline preferences have changed.

One knowledgeable in the art would not consider the Ludewig Java applets to be “cookie processing script” as used in the present claims application. Furthermore, the Ludewig technology cannot properly be combined with that taught in the Capps and Pogue patents.

B. Pogue does not attach the new cookie values to an image request associated with a designated URL source (Claim 3)

Claims 2, 3 and 5-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Capps, et al. and Durham as applied to Claim 1, and further in view of U.S. Patent No. 6,112,240 (Pogue, et al.)

Claim 3 includes the steps of “attaching the new cookie values to an image request” associated with a designated URL source, and “sending the image request to the URL source.”

An example of this action would be to send the newly provided cookie values from the visitor computer to a tracking computer.

Pogue does not describe this feature. Citing to the portion identified by the Examiner (Pogue, Col. 7, lines 11-22), Pogue instead only transmits a new cookie from the tracker 310 to the browser 302 thereby replacing the cookie on the visitor computer. Pogue does not teach that the cookie is then attached to an image request associated with a designated source.

Reconsideration and allowance of the claims is thus respectfully requested.

C. It would not be obvious to implement the features of Pogue within Capps and Ludewig

Pending claims 1-8 have been rejected under §103(a) as being an obvious combination of several references (Capps, Ludewig, Pogue, Davis, and Shrader). These references teach very different aspects of computer usage, including:

CAPPS – computer setting migration manager (does not involve traffic analysis).

LUDEWIG – method for using cookies in java (does not involve traffic analysis).

POGUE – visitor tracking programs for traffic analysis.

DAVIS – client tracking using server-supplied cookie.

SHRADER – cookie construction and validation method for client authentication.

The attempted combination of all of these disparate references to teach elements of a single claim rises to the level of hindsight analysis that runs counter to obviousness analysis as articulated by the law and interpreted by the courts.

The Federal Circuit has been consistent in reversing the PTO when a rejection is made on the basis of hindsight, that is when an Examiner rejects the application under 35 U.S.C. §103(a) grounds as obvious under a combination of two or more patents without any specific suggestion within the patents to combine the features. In re Rouffett, 47 USPQ2d 1453 (Fed. Cir. 1998), the Federal Circuit refused to uphold an obviousness rejection, even where skill in the art is high, absent the specific identification of principal, known to one of ordinary skill in the art that suggests the claimed combination.

The Federal Circuit reemphasized the care to be taken when combining prior art references in obviousness findings in Ecolochem v. Southern Cal. Edison, 56 USPQ2d 1065 (Fed. Cir. 2000), stating that such absence of evidence to combine prior art references “is defective as hindsight analysis.” The Federal Circuit held similarly in In re Kotzab, 55 USPQ2d

1313 (Fed. Cir. 2000), reversing the PTO and stating that, “[i]dentification of prior art statements that, in abstract, appear to suggest claimed limitation does not establish prima facie case of obviousness without finding as to specific understanding or principal within knowledge of skilled artisan that would have motivated one with no knowledge of the invention to make the combination in the manner claimed.”

Finally, the Federal Circuit has reaffirmed their view that the PTO used improper hindsight analysis to reject patent claims under §103(a) in the recent case of In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), stating that a specific suggestion in the prior art cited is required and not a simple citation to “common knowledge and common sense.” Lee includes a tour-de-force of case law directed to the issue of combining references including those as follows:

- “The factual inquiry whether to combine references must be thorough and searching. . . . It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” (Lee, 277 F.3d at 1343)
- “A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding.” (*quoting* Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000))
- “Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” (*quoting* C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998))
- “There must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.” (*quoting* In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)).
- “Teachings of references can be combined *only* if there is some suggestion or incentive to do so.” (*quoting* In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis in original))

The Patent Office has failed to display the rigor required by the Federal Circuit holdings in demonstrating a suggestion within the art that the cited prior art references should be combined. For instance, the primary reference Capps concerns itself solely with a method for migrating user settings from a source computer to a destination computer. Capps does not address web site browsing, does not implicate web traffic tracking, and does not teach cookie manipulation. Whereas the present invention is directed to the client-side processing of a cookie to overcome security features against third-party cookies, Capps is not even in the same field of study.

It would seem, in fact, that Capps teaches away from the present invention. The present invention results in new (e.g. most likely different) cookie values. In contrast, the whole purpose of Capps is to transfer the same configuration information. Transferring different configuration information would defeat the whole purpose of Capps. Furthermore, Capps confines itself to the transfer of settings from one client computer to another. In contrast, the present invention stores new cookie values on the same computer.

Finally, none of the references teach the core concept of client-side cookie processing as the cited art of record only teaches that such duties are handled by external servers. No motivation has been presented for picking and choosing elements from various independent embodiments across multiple patents without the inference of hindsight. Accordingly, the five references fail as a matter of law to (1) teach all elements of the claims, and (2) suggest that combination would be possible given the desperate fields of endeavor and goals of the various references cited. Reconsideration and allowance of all claims is thus respectfully requested.

II. Claims 14-17

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bharat (US Patent No. 6,810,395) and de l'Etraz, et al. (US Patent No. 6,073,138).

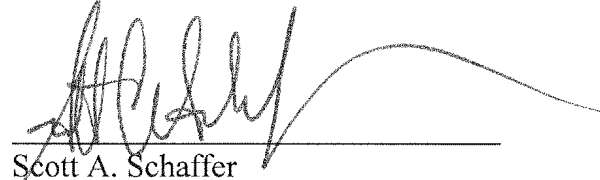
Claim 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bharat and de l'Etraz as applied to claim 14 above, and further in view of Pogue.

Claim 14 has been amended to cite that the cookie processing script is associated with a different domain than the web page—that is, where the web page provider and the (web tracking) service provider are different entities. Bharat and de l'Etraz do not contemplate this feature.

For the foregoing reasons, reconsideration and allowance of claims 1-8 and 14-17 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in black ink, appearing to read 'Scott A. Schaffer', is written over a horizontal line.

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